



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/664,234

09/17/2003

Yijun Ruan

3240-0105

3948

6449

7590

09/07/2010

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

JOHANNSEN, DIANA B

ART UNIT

PAPER NUMBER

1634

NOTIFICATION DATE

DELIVERY MODE

09/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/664,234	Applicant(s) RUAN ET AL.	
	Examiner Diana B. Johannsen	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 39-41.
 Claim(s) objected to: _____.
 Claim(s) rejected: 25-27, 29, 31-38, 44-50 and 53.
 Claim(s) withdrawn from consideration: 1-24, 42 and 43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Diana B. Johannsen/
 Primary Examiner, Art Unit 1634

Continuation of 3. NOTE: It is noted that applicant's proposed amendments to claims 33 and 37 would overcome the rejection of those claims under 35 USC 112, second paragraph; however, the proposed amendments also raise additional new matter issues and thus have not been entered. See box 11 below regarding the new matter rejection of record. Applicant's proposed amendments to claims 33 and 37 result in those claims being directed to embodiments that also appear to lack basis in the originally filed specification (of adding a restriction enzyme to "the full-length coding sequence of" a cDNA transcript [claim 33] and cleaving "the full-length coding sequence" with MmeI [claim 37])..

Continuation of 11. does NOT place the application in condition for allowance because: for the reasons of record in view of the non-entry of the after-final amendment. Applicant's traversal of the new matter rejection of record has been fully considered but is not persuasive. It is again noted that claims 25-26 requiring producing "at least one full length coding sequence of a cDNA transcript" and subsequent cleaving of the produced "full length coding sequence" (not of the cDNA transcript or of a cDNA including a full length coding sequence; rather, the claims require providing and cleaving the "full length coding sequence" itself). Such a molecule differs from a cDNA that contains or includes a full length coding sequence. Regarding Figures 1-2, it is agreed that the figures depict preparation of a full length cDNA transcript that would be expected to contain a full length coding sequence. However, the figures do not depict preparation of a molecule including only the coding sequence portion of a transcript (e.g., a molecule lacking sequences corresponding to 5' UTR, 3' UTR, etc., as would be expected to be present in a cDNA corresponding to a full length mRNA). Further, the fact that 5' and 3' tags of the invention "delineate the starting and ending points of transcripts" is not in dispute herein; rather, the specification lacks basis for the particular requirements of claims 25-26 to provide a "full length coding sequence" of a cDNA transcript and to subsequently cleave that coding sequence. Accordingly, applicant's arguments are not persuasive..